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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,956	12/08/2003	Norikazu Niimi	118002	9053
25944	7590	11/17/2004		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER MAI, NGOCLAN THI	
			ART UNIT 1742	PAPER NUMBER

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/728,956

Applicant(s)

NIIMI, NORIKAZU

Examiner

Ngoclan T. Mai

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11 and 12 is/are rejected.
- 7) ☒ Claim(s) 8-10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite because while claim 1 recites a method of producing a sintered body, there is no positive active method step in the claims. Note that a proper method claim must have at least one positive active step recited.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by JP06107456.

JP06107456 disclosed the claimed sintered body formed by calcining a powder mixture of  $\text{Al}_2\text{O}_3$  and  $\text{Y}_2\text{O}_3$ , pulverizing the calcined mixed powder, molding the pulverized mixed powder and heating the molded product in nitrogen atmosphere. While

the sintered body is not formed by employing aluminum nitride as sintering aid, there is no apparent distinction between the claimed sintered body and that of JP06107456.

Note that it has been established that a product by process claim is directed to the product per se, no matter how actually made, *In re Kirao*, 190 USPQ 15 at 17 (footnote 3). See also *In re Thorpe*, 227 USPQ 964 (CAFC 1985), which makes it clear that it is the patentability of the final product per se which must be determined in a product by process claim and not the patentability of the process. An old or obvious product produced by a new method is not patentable as a product, whether claimed in a product by process claims or not. Note that applicant has the burden of proof in such case.

5. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Chia et al.

Chia et al. disclose employing nitrogen containing aluminum compounds such as aluminum nitride for use as sintering aid for forming SiC body. See col. 4, lines 12-25. While Chia et al do not teach aluminum nitride used for producing a sintered body of yttrium aluminum garnet, the claimed intended use of the claimed alloy does not lend patentability to the alloy. A mere statement of a new use for an otherwise old or obvious composition cannot render a claim to the composition patentable. See *In re Lemin*, 51 CCPA 942, 326 F.2d 437, 140 USPQ 273 (1964), *In re Thuau* 135 F.2d 344, 57 USPQ 324 (CCPA 1943), *Ex parte Douros* 163 USPQ 667 (POBA), and *In re Craige*, 188 F.2d 505, 89 USPQ 393 (CCPA 1951). Furthermore, the claimed properties are mere material properties which would have been inherently possessed by the materials of cited references. See *In re Best*, 195 USPQ 430 and MPEP § 2112.01 .

6. Claims 1-7 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
7. Claims 8-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. The following is a statement of reasons for the indication of allowable subject matter:

Chia et al teach forming silicon carbide bodies employing rare earth oxide and nitrogen containing compound such as aluminum nitride as sintering aids.

Miyahara discloses employing compounds of group IIA, IIIA and IIIB metals of the periodic table and preferably comprising predominantly  $Y_2O_3$  as sintering additive for forming aluminum nitride sintered body, see abstract.


Nakahara et al teach forming ceramic member comprising at least 10% by volume of a compound of yttrium aluminum garnet and not more than 90% by volume of at least an oxide phase selected from aluminum oxide, yttrium oxide and aluminum nitride. There is no teaching or suggest that aluminum nitride or the use aluminum nitride in an amount that acts as a sintering aid.

There is no teaching or it is obvious to make sintered yttrium aluminum garnet by employing aluminum nitride as a sintering aid

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoclan T. Mai whose telephone number is (571) 272-1246. The examiner can normally be reached on 9:30-6:00 PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Ngoclan T. Mai  
Primary Examiner  
Art Unit 1742

n.m.